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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,567	03/15/2004	Klaus M. Irion	02581-P0560A	9815
24126 7590 01/22/2007 ST. ONGE STEWARD JOHNSTON & REENS, LLC 986 BEDFORD STREET STAMFORD, CT 06905-5619			EXAMINER KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/22/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/800,567

Applicant(s)

IRION, KLAUS M.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on November 6, 2006, amended claims 1 and 16; canceled claims 15 and 30; and new claims 31-34 are acknowledged. The current rejections of the claims are *withdrawn*. The following new grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7-8, 10-14, 16-18, 21, 24-25 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,681,260 to Ueda et al.

**In regards to claim 1**, Ueda et al. disclose an intracorporeal probe for at least one of examination and therapy of body cavities in the human or animal body, said probe being in the form of a capsule 150 which can be introduced into the body without external connection elements, and said probe having at least one light-emitting element 154 and at least one light-receiving element 152, wherein said at least one light-receiving element receives light in another wavelength range than that in which said at least one light-emitting element emits light wherein said capsule contains a position-detecting element 159 whose position can be determined from outside the body an

which is capable to detect at least one of a position and an orientation of said probe with respect to axes of said probe relative to said body cavity (see Col. 18, Lines 9-67).

**In regards to claims 3-5**, Ueda et al. disclose an intracorporeal probe, wherein said at least one light-emitting element is a light-emitting diode 154 and wherein said at least one light-emitting element has an emission characteristic covering the entire solid angle (see Fig. 27).

**In regards to claims 7-8**, Ueda et al. disclose an intracorporeal probe, wherein said at least one light-receiving element is designed in such a way that it receives light from the entire solid angle range and wherein a plurality of light-receiving elements are arranged in said capsule in such a way that light can be received from the entire solid angle range (see Fig. 27).

**In regards to claim 10**, Ueda et al. disclose an intracorporeal probe, wherein said capsule contains at least one further light-receiving element 153 in the form of an image sensor for the purpose of receiving a visual image (see Col. 18, Lines 9-67).

**In regards to claim 11**, Ueda et al. disclose an intracorporeal probe, wherein said capsule contains at least one further light-emitting element which emits white light (see Fig. 27).

**In regards to claim 12**, Ueda et al. disclose an intracorporeal probe, wherein said capsule contains a transmitter element 161 and 157 for the purpose of emitting signals from said probe to outside the body (see Fig. 27-28).

**In regards to claim 13**, Ueda et al. disclose an intracorporeal probe, wherein said capsule contains a signal-preprocessing element 156 and 157 which forwards an

opto-electrical signal originating from said at least one light-receiving element to said transmitter element (see Fig. 27-28).

**In regards to claim 14**, Ueda et al. disclose an intracorporeal probe, wherein said capsule contains a signal storage element 156 for the purpose of storing signals of said at least one light-receiving element (see Col. 18, Lines 28-40).

**In regards to claims 16-17**, Ueda et al. disclose an intracorporeal probe, wherein said position-detecting element is designed as a coil system whose position can be detected via an external magnetic field detector and wherein said capsule contains a positioning element which can be controlled from outside the body in order to position said probe (see Col. 18, Line 43 - Col. 19, Line 18).

**In regards to claim 18**, Ueda et al. disclose an intracorporeal probe, wherein said capsule contains at least one of an energy supply unit and an element for receiving electromagnetic energy irradiated from outside the body (see Col. 18, Line 43 - Col. 19, Line 18).

**In regards to claim 21**, Ueda et al. disclose an intracorporeal probe wherein, said capsule contains a reservoir for at least one of therapeutic substances and diagnostic substances which are dispensed inside the body by said probe (see Col. 18, Lines 59-60).

**In regards to claim 24**, Ueda et al. disclose an intracorporeal probe wherein, wherein said probe is designed as an implant and has a capsule wall formed with long-term biocompatible and sterilizable material (see Fig. 27).

**In regards to claims 25 and 32**, Ueda et al. disclose an intracorporeal probe wherein said probe has a fully enclosing transparent capsule wall (see Fig. 27).

Claims 1-14, 16-18, 21-29 and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0051766 to Gazdzinski.

**In regards to claims 1 and 16-18**, Gazdzinski discloses an intracorporeal probe for at least one of examination and therapy of body cavities in the human or animal body, said probe being in the form of a capsule 300 which can be introduced into the body without external connection elements, and said probe having at least one light-emitting element and at least one light-receiving element, wherein said at least one light-receiving element receives light in another wavelength range than that in which said at least one light-emitting element emits light wherein said capsule contains a position-detecting element whose position can be determined from outside the body and which is capable to detect at least one of a position and an orientation of said probe with respect to axes of said probe relative to said body cavity (see Figs. 3 and 5 and paragraph 63).

**In regards to claims 2-6**, Gazdzinski discloses an intracorporeal probe, wherein said at least one light-emitting element is a light-emitting diode 154 and wherein said at least one light-emitting element has an emission characteristic covering the entire solid angle (see paragraph 0155 and Fig. 5).

**In regards to claims 7-9**, Gazdzinski discloses an intracorporeal probe, wherein said at least one light-receiving element is designed in such a way that it receives light

Art Unit: 3739

from the entire solid angle range and wherein a plurality of light-receiving elements are arranged in said capsule in such a way that light can be received from the entire solid angle range (see Fig. 5).

**In regards to claim 10**, Gazdzinski discloses an intracorporeal probe, wherein said capsule contains at least one further light-receiving element 402 in the form of an image sensor for the purpose of receiving a visual image (see Col. 18, Lines 9-67).

**In regards to claim 11**, Gazdzinski discloses an intracorporeal probe, wherein said capsule contains at least one further light-emitting element which emits white light (see Fig. 5).

**In regards to claim 12**, Gazdzinski discloses an intracorporeal probe, wherein said capsule contains a transmitter element and for the purpose of emitting signals from said probe to outside the body (see Fig. 5).

**In regards to claim 13**, Gazdzinski discloses an intracorporeal probe, wherein said capsule contains a signal-preprocessing element 156 and 157 which forwards an opto-electrical signal originating from said at least one light-receiving element to said transmitter element (see paragraphs 0145-0151).

**In regards to claim 14**, Gazdzinski discloses an intracorporeal probe, wherein said capsule contains a signal storage element 156 for the purpose of storing signals of said at least one light-receiving element (see paragraphs 0145).

**In regards to claim 21**, Gazdzinski discloses an intracorporeal probe wherein, said capsule contains a reservoir for at least one of therapeutic substances and

Art Unit: 3739

diagnostic substances which are dispensed inside the body by said probe (see paragraphs 54-60).

**In regards to claim 22**, Gazdzinski discloses an intracorporeal probe wherein, wherein an ultrasound transmitter/receiver element for ultrasound imaging is arranged in said probe (see paragraph 0039).

**In regards to claim 23**, Gazdzinski discloses an intracorporeal probe wherein, wherein said probe has at least one line leading to outside the body for the purpose of exchanging at least one of information, energy and substances (see Figs. 13-14).

**In regards to claim 24**, Gazdzinski discloses an intracorporeal probe wherein, wherein said probe is designed as an implant and has a capsule wall formed with long-term biocompatible and sterilizable material (see Fig. 5).

**In regards to claims 25 and 32**, Gazdzinski discloses an intracorporeal probe wherein said probe has a fully enclosing transparent capsule wall (see Fig. 5).

**In regards to claims 26-29 and 33-34**, Gazdzinski discloses an intracorporeal probe wherein said capsule contains at least one element emitting therapeutic light, said element emitting light for photodynamic therapy principally in the wavelength range in which an absorption peak of a photosensitizer introduced into the body lies, and wherein said at least one light-receiving element and said at least one element emitting therapeutic light are oriented in such a way that therapeutic light can be emitted locally in the solid angle in which a fluorescent signal is received by said at least one light-receiving element, which signal is produced by excitation light emitted by said at least one light-emitting element (see paragraphs 0013-0037).



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14, 17-18, 23-29 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,240,312 to Alfano et al. in view of U.S. Patent No. 5,681,260 to Ueda et al.

In regard to claims 1-8, 10, 12-14, 24, 25 and 30, Alfano et al. teach a device 11 including a transport capsule 13 made of a smooth and non-corrosive material, such as Teflon, stainless steel, silicon or gold, which are biocompatible, where the capsule 13 houses a spectroscopic system 14, a motion mechanism 15, a surgical system 17, a laser system 19, a communications system 21, a light source 23, an imaging system 25 and a power system 27, all of which are coupled to a microcomputer and controller 29 (see Figure 1 and col. 4, lines 25-50). The imaging system preferably comprises a micro-video CCD and LED light sources that are preferably three color LED diodes, where the three colors LED diodes (red, green and blue as is conventional) would emit light in a shorter wavelength than the light received by the imaging system 25 (see col. 6, lines 12-17). Figures 2 and 3 show that, as broadly as claimed, the light emitted by the LED diodes and the light received by the imaging system 25 covers the entire solid angle seen by the capsule 13. However, Alfano et al. are silent with respect wherein the capsule contains a position-detecting element whose position can be determined from

Art Unit: 3739

outside the body and which is capable to detect at least one of a position and an orientation of said probe with respect to axes of said probe relative to said body cavity. Ueda et al. teach of an analogous capsule endoscope wherein a magnetic field is generated from the magnetic force generating part 31, a magnetic force is generated between this magnetic force generating part 31 and the guided part of the capsule type endoscope 150, the magnetic force generating part 31 is moved and the capsule type endoscope 150 is guided. By detecting the position of the guided part 159 with the hall sensor 131, the position of the capsule type endoscope 150 is detected (see Col. 18, Lines 9-67). It would have been obvious to one skilled in the art at the time the invention was made to include a position detecting element in the apparatus of Alfano et al. to provide a guiding apparatus and method for magnetically guiding an insertable body within an inspected object wherein the guidance controllability in the case of guiding is high as taught by Ueda et al. (see Col. 2, Line 59 – Col. 3, Line 45).

**In regard to claim 9**, Alfano et al. teach the use of filters on the imaging and illumination system of the capsule 13 (see col. 6, lines 21-34). **In regard to claim 11**, Alfano et al. teach the use of micro flash lamps for illumination, which would emit white light (see col. 6, lines 17-21). **In regard to claim 23**, Alfano et al. teach an alternate embodiment where the device 153 is connected to an external computer system C via a wire cable that delivers operation commands and electrical power (see Figure 11b and col. 7, lines 15-30). **In regard to claims 26-29 and 33-34**, Alfano et al. teach the use of a semiconductor diode laser system as a surgical source to ablate tissue or weld tissues together (see col. 6, lines 50-65).

Claims 19-20 and 31 are rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent No. 5,681,260 to Ueda et al. in view of U.S. Patent No. 6,668,185 to Toida.

**In regards to claims 19-20 and 31**, Ueda et al. disclose an intracorporeal probe for at least one of examination and therapy of body cavities in the human or animal body, said probe being in the form of a capsule 150 which can be introduced into the body without external connection elements, and said probe having at least one light-emitting element 154 and at least one light-receiving element 152, wherein said at least one light-receiving element receives light in another wavelength range than that in which said at least one light-emitting element emits light wherein said capsule contains a position-detecting element 159 whose position can be determined from outside the body and which is capable to detect at least one of a position and an orientation of said probe with respect to axes of said probe relative to said body cavity (see Col. 18, Lines 9-67). Ueda et al. are silent with respect to at least one luminescent substance which can be excited by excitation from outside the body and emits light through a capsule wall. Toida teaches of an analogous endoscopic device provided with an SLD (Super Luminescent Diode) 101 for emitting a low-coherence light L1, and a lens 102 for focusing the low-coherence light L1 emitted from said SLD 101. It would have been obvious to one skilled in the art at the time the invention was made to include a luminescent substance in the apparatus of Ueda et al. to provide an alternate means of illumination having a low-coherence as taught by Toida.

***Response to Arguments***

Art Unit: 3739

Applicant's arguments filed November 6, 2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., injection of a drug that contains a photosensitizing agent and is absorbed by a certain type of cell) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As broadly as claimed, Alfano Gazdzinski discloses an element emitting therapeutic light, said element emitting light for photodynamic therapy principally in the wavelength range in which an absorption peak of a photosensitizer introduced into the body lies. Aflano et al. teach the use of a semiconductor diode laser system as a surgical source to ablate tissue or weld tissues together (see col. 6, lines 50-65).

Furthermore applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

Art Unit: 3739

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John P. Leubecker  
Primary Examiner

MJK *ML*

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